

### **REMARKS**

This responds to the Office Action mailed on March 2, 2006.

Claims 1, 5, 7, and 9-16 are amended; as a result, claims 1-16 are now pending in this application.

#### **§112 Rejection of the Claims**

Claims 1, 11 and 14 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended the claims to include, e.g., Vcc current and Vss current. Support for the clarification amendments comes from the specification. Withdrawal of the rejection is respectfully requested.

#### **§102 Rejection of the Claims**

Claims 1-8, 11 and 14 were rejected under 35 USC § 102(b) as being anticipated by Mak et al. (U.S. 6,222,246). The Applicant respectfully traverses this rejection and requests the Office to consider the following.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” (*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), M.P.E.P. §2131, 8<sup>th</sup> Ed., Rev. 4).

Claim 1 requires “providing a decoupling capacitor between an electrical first bump and an electrical second bump” (claim 1). The decoupling capacitor 280 illustrated in FIG. 2 of Mak is located below the electrical bumps 284. The directional language of claim 1, i.e., “between”, “upwardly”, and “downwardly” teaches away from Mak. All of the pertinent illustrations in the instant application support the language “between”, which is not taught by Mak. Mak teaches providing a decoupling capacitor below the electrical bumps. With respect to comparing Mak strictly only with the instant claims, one cannot assert that the capacitor 280 is between the

bumps 284 since the capacitor extends beyond the boundaries of the capacitors 284. Withdrawal of the rejection is respectfully requested.

Applicant notes that claims 2-10 depend from independent claim 1 and are therefore also not anticipated by Mak. Applicant notes that claims 15 and 16 depend from independent claim 14 and are therefore also not anticipated by Mak. Applicant notes that claims 2-10 depend from independent claim 1 and are therefore also not anticipated by Mak.

Regarding claims 2, 3, and 4, Applicant respectfully requests the Office to show in Mak, where any wiring pattern other than that illustrated in FIG. 2 is given. The language of the Office “various possible wiring patterns” indicates an assertion of lack of anticipation by Mak, and therefore the rejection would be improper under the Statute. Otherwise, withdrawal of the rejection is respectfully requested.

Claims 1-16 were rejected under 35 USC § 102(e) as being anticipated by “applicants prior art.” Applicant respectfully traverses the rejection and requests the Office to consider the following.

Independent claims 1, 11, and 14 all require the limitation “directing a Vcc current upwardly from the decoupling capacitor and the electrical first bump toward the component”. The directional limitations of the independent claims include:

directing a Vcc current

(1) “upwardly from the decoupling capacitor” and

(2) “the electrical first bump”

(3) “toward the component”

is not taught in FIG. 11. FIG. 11 illustrates directing a Vcc current downwardly from the decoupling capacitor. Next, as illustrated the “first pre-component direction 66” is neither upwardly nor downwardly, but since the “first pre-component direction 66” is not directed upwardly from the decoupling capacitor 30, neither does the “first pre-component direction 66” allow FIG. 11 to anticipate what is claimed. The independent claims are therefore not anticipated by FIG. 11. Withdrawal of the rejections is respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney John Greaves at 801-278-9171 to facilitate prosecution of this application.


If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

DAMION T. SEARLS ET AL.

By their Representatives,  
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, Minnesota 55402  
(801) 278-9171

By /

  
John N. Greaves  
Reg. No. 40,362